

REMARKS-General

1. The amended independent claim 21 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All claims 21-37 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

Regarding to Rejection of Claims 21 and 24 under 35USC102

2. Pursuant to 35 U.S.C. 102, "a person shall be entitled to a patent unless:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

3. In view of 35 U.S.C. 102(e), it is apparent that a person shall not be entitled to a patent when his or her invention was described in an application patent which is published under section 122(b) by another filed in the United States before the invention by the applicant for patent.

4. However, the Loga et al patent (US 6,746,133) and the instant invention are not the same invention according to the fact that the independent claim 1 of the Loga patent does not read upon the instant invention and the independent claim 21 of the instant invention does not read upon the Loga patent too. Apparently, the instant invention, which discloses a ceiling fixture having a light enhancing frame, should not be the same invention as the Loga patent which discloses a luminaire having a color filter.

5. Accordingly, the instant invention provides two functions by using one single light source. The light source generates light at the main light chamber for illumination. The light from the same light source is diffused to the light enhancing chamber to

highlight the shaded window to provide an added light effect. It is worth to mention that the light source must be powerful enough to generate high intensity of light for illumination purpose. However, the shaded window will be over lightened so as to weaken the added light effect at the shaded window. On the other hand, when the light intensity of the light is reduced to enhance the added light effect at the shaded window, the light source cannot be used for illumination. Therefore, the main objective of the instant invention is to use one single light source that the light intensity within the main light chamber for illumination is higher than a light intensity within the light enhancing chamber for providing an added light effect at the light enhancing window.

6. However, Loga fails to anticipate the following distinctive features as claimed in the amended claim 21.

(I) The light enhancing frame, which is made of light-opaque material, has at least a shaded window for allowing the light passing therethrough. Loga merely discloses a light-permeable diffuser 6 such that the light is adapted to pass through the light-permeable diffuser 6.

(II) The light source is supported **below** the light enhancing frame for diminishing the light from the light source directly projecting to the light enhancing frame. Loga merely discloses a light-permeable diffuser 6 positioned around the lamp 1, however, Loga fails to anticipate the lamp 1 is positioned below the light entry region 4. As shown in Figs. 1 to 5 of Loga, the lamp 1 is positioned at the light entry region 4 such that the light from the lamp 1 directly projects (not diffuse) to the light-permeable diffuser 6. In other words, Loga fails to anticipate the light **diffuses** to the light enhancing chamber.

(III) A portion of light directly projects to the light dispersing housing within the main light chamber for illumination and a portion of the light radially and upwardly **diffuses** towards the light enhancing chamber such that a light intensity within the main light chamber is higher than a light intensity within the light enhancing chamber. Loga merely anticipates the light intensity within the raster 2 is higher than that between the reflector 3 and the diffuser 6. However, the color filter 5 must be formed at the light entry region 4. The instant invention, which does not require any filter that the light is

dimmed with the color filter 4, controls the light intensity by the structure of the light enhancing frame.

(IV) The instant invention requires minimum components to control the light intensity of the light source by the structural configuration thereof. The light enhancing frame has a surrounding wall coaxially and outwardly extended from the light dispersing housing to the ceiling supporting frame for the light diffusing from the light dispersing housing to the light enhancing frame. No additional component is required to diffuse the light from the light source.

7. Regarding to claim 24, Loga merely anticipates an upper surrounding edge of the diffuser 6 coaxially extended from the container 8 and a lower surrounding edge coaxially coupling with the raster 2. However, Loga fails to anticipate the lower surrounding edge coaxially couples with the light dispersing housing to minimize the light diffusing to the light enhancing chamber. In addition, the surrounding wall of the light enhancing frame is inclinedly and outwardly extended from the light dispersing housing to the ceiling supporting frame to form the light enhancing chamber so as to diminish said light from said light source diffusing to said light enhancing frame. However, the ceiling fixture of Loga discloses the surrounding wall of the diffuser 6 is inclinedly and inwardly extended to enhance the light intensity directly projecting thereto.

8. Accordingly, applicants believe that the rejection of claims 21 and 24 is improper and should be withdrawn.

Response to Rejection of Claims 22-23 and 25-37 under 35USC103

9. The Examiner rejected claims 22-23 and 25-37 over Loga et al (US 6,746,133) in view of Tsuji et al (US 6,450,658), Hus (US 6,623,138), McCarthy et al (US 6,042,251) and Jaffari et al (US 6,478,454). Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

10. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

11. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Loga which is qualified as prior art of the instant invention under 35USC102(e) are obvious in view of Tsuji, Hus, McCarthy and Jaffari at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

12. However, as recited above, Loga merely discloses a lamp 1 generates light directly projecting to the diffuser 6 through the color filter 5 at the light entry region 4. Therefore, the difference between Loga and the instant invention as claimed in claims 21 to 37 is not limited to the disclosure of "light fixture", but includes the above distinctive features (I) to (IV). In addition, regarding to claims 22 to 37, the instant invention further contains the following distinctive features.

13. Regarding to claims 22 and 23, a through groove is formed on the surrounding wall of the light enhancing frame to form the light enhancing frame, wherein a light softening laying is provided on the surrounding wall to form the shaded window for softening the light dispersing through the shaded window. The examiner alleges that Tsuji teaches a translucent window formed on the upper housing, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to modify the diffuser 6 of Loga to incorporate the translucent window of Tsuji. However, even the translucent window taught by Tsuji is formed on the diffuser of Loga, the ceiling fixture of Loga cannot provide an added light effect of the ceiling fixture. The lamp of Loga directly projects light to the translucent window such that the light intensity at the translucent window is the same as the intensity at the raster. As mentioned above, the translucent window will be over lightened so as to weaken the added light effect at the translucent window. Therefore, Tsuji teaches two light sources that one of them is used for illumination and another one is used for providing relatively low light intensity at the

translucent window. In other words, modifying Loga with Tsuji, as proposed by the Examiner, would not provide a relatively high intensity light at the main light chamber for illumination and a relatively low intensity light at the shaded window by diffusing the light from the same light source. The applicant respectfully submits a person who skilled in the art at the time of the invention was made cannot to modify the fixture of Loga by positioning the light source below the light enhancing frame to diffuse the light from the light source to the shaded window.

14. Regarding to claims 25-29 and 34-35, Tsuji merely teaches the surrounding wall of the upper housing 18 inclinedly and outwardly extended from the lower housing 17. However, Tsuji fails to teach the surrounding wall of the light enhancing frame is extended from the light dispersing housing to diminish the light from the light source diffusing to the light enhancing frame. In addition, the retaining rim at the lower surrounding edge of the light enhancing frame is coaxially and inwardly extended between the main light chamber and the light enhancing chamber for controlling the light passing from the main light chamber towards the light enhancing chamber. Tsuji never mentions any retaining rim inwardly extended to control the light passing to the light enhancing chamber since the light is generated by the upper light assembly 21 directly to the translucent window 27 but not diffused to the light enhancing chamber. Therefore, no retaining rim is needed in Tsuji's ceiling fixture to control the light diffusing from the light source.

15. Regarding to claims 30-32 and 36-37, the instant invention discloses a heat insulating layer provided on the ceiling panel for blocking heat from the light source towards said ceiling and a bottom light reflective surface formed on the ceiling panel for substantially reflecting the light from the light source towards the light enhancing chamber and the main light chamber. Loga merely teaches a concave reflector 3 reflecting the light from the lamp 1 to the diffuser 6 such that the light intensity at the diffuser 6 is the same as the light intensity at the raster 2. McCarthy merely teaches a parabolic reflector 184 for light reflecting to the lens 144. However, both Loga and McCarthy never mention any light reflective surface for reflecting the light from the light source towards the light enhancing chamber and the main light chamber at the same time. Therefore, the light intensities at the main light chamber and the light enhancing chamber are correspondingly enhanced while the light intensity at the main light

chamber for illumination is still higher than the light intensity at the light enhancing chamber to provide the added light effect at the shaded window.

16. Regarding to claim 33, the light enhancing window is a light gap formed between an upper surrounding edge of the light enhancing frame and the ceiling supporting frame for communicating the light enhancing chamber with the exterior of the light enhancing frame such that when the portion of light diffuses to the light enhancing chamber, the portion of light dispenses to the exterior of the light casing through the light gap. Jaffari merely teaches light 44 directed upwardly from the arc tube 20 can then pass through the transparent (or translucent) section 45 to provide for up-lighting as well as side lighting, in column 3, lines 33-44, without mentions any light enhancing chamber allowing the light from the light source diffusing thereto.

17. The Examiner appears to reason that since Loga teaches that a light from a lamp directly projecting towards the diffuser, it would have been obvious to one skilled in the art to modify Loga's light fixture with Tsuji, Hus, McCarthy, and Jaffari. But this is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. See *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")

18. In the present case, there is no such suggestion. Loga, Tsuji, Hus, McCarthy, and Jaffari perform very different types of light fixture. In any case, even combining Loga, Tsuji, Hus, McCarthy, and Jaffari would not provide the invention as claimed -- a clear indicia of nonobviousness. *Ex parte Schwartz*, slip op. p.5 (BPA&I Appeal No. 92-

2629 October 28, 1992), ("Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed."). That is, modifying the light fixture of Loga with Tsuji, Hus, McCarthy, and Jaffari, as proposed by the Examiner, would not provide a ceiling fixture using one single light source to generate light at the main light chamber for **illumination** and to diffuse to the light enhancing chamber to highlight the shaded window to provide an added light effect.

19. Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

The Cited but Non-Applied References

20. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

21. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection are requested. Allowance of claims 21-37 at an early date is solicited.

22. Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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